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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,475	07/09/2001	Dominique Briere	011496/236625	7468

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EXAMINER

DAVIS, ROBERT B

ART UNIT

PAPER NUMBER

1722

DATE MAILED: 10/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/902,475

Applicant(s)

BRIERE ET AL.

Examiner

Robert B. Davis

Art Unit

1722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07 September 2004 has been entered.

Reissue Applications

2. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

The reissue declaration is defective because it fails to identify foreign application (France 95 04651) and International application (PCT/FR96/00576).

It does not identify the foreign application for patent or inventor's certificate on which priority is claimed pursuant to 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month and year of its filing.

3. Claims 22-44 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

4. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed. Applicant amended claims 22-31 in response to the office action of 14 April 2003. Applicant has also filed new claims 32-44, which were not covered by the originally filed reissue declaration.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

5. Claims 22-44 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue, which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Original claim 1 of the patent included the following limitations.

1. Device for manufacturing containers, made of a thermoplastic by blow molding or stretch-blow molding of a preheated preform, the said device including at least one mold (1) consisting of two half-molds (2) respectively supported by two mold carriers (3) which can move one with respect to the other, characterized in that each half-mold (2) comprises a shell holder (9) supported by the respective mold carrier (3) and a shell (7) which is provided with a half-impression (8) of the container to be obtained and which can be removably fastened to its shell holder (9) by quick-fixing means (19-23), the shell (7) and the shell holder (9) being in complementary shapes in order to be in at least partial mutual thermal-conduction contact while the pipes and connections for the circulation of cooling and/or heating fluids (11, 12) are provided exclusively in the shell holder.

The claim was amended to recite the following:

1. Device for manufacturing containers, made of a thermoplastic by blow molding or stretch-blow molding of a preheated preform, the said device including at least one mold (1) consisting of two half-molds (2) respectively supported by two mold carriers (3) which are made in the form of enveloping structures and which can move one with respect to the other, characterized in that each half-mold (2) comprises a shell holder (9) supported by the respective mold carrier (3) and a shell (7) which is provided with a half-impression (8) of the container to be obtained and which can be removably fastened to its shell holder (9) by quick-fixing means (19-23), the shell (7)

and the shell holder (9) being in complementary shapes in order to be in at least partial mutual thermal-conduction contact while the pipes and connections for the circulation of cooling and/or heating fluids (11, 12) are provided exclusively in the shell holder.

Claim 22 recites a mold assembly comprising two mold shells and two mold shell holders and at least two axial positioning assemblies. Claim 22 does not include the mold carriers in the form of enveloping structures or the at least one quick fixing means. Claim 27 includes the mold shell, at least two coupling members and the shell holders. Claim 27 does not include the mold carriers in the form of enveloping structures or the at least one quick fixing means.

Hence, these claims are broader than the patent claim 1. Further, the subject matter of original claim 1 was amended to overcome an art rejection. Applicant added to the limitation of "two mold carriers" the following phrase "which are made in the form of enveloping structures". On page 6 of the amendment filed September 28, 1998, applicant argues "Appel does not teach or suggest a device with mold carriers which sound (typo for surround) respective shell holders. Moreover, even if one imagines that elements 43, 44 in Appel are shell holders, that elements, 130, 131 are shells and that elements (axis and arms 118-121) are mold carriers, such an argument would be erroneous from a structural point of view. This is true for at least the reason that the above-mentioned elements are obviously pivot elements corresponding to axis 4 of the present invention. Moreover, even assuming arguendo that rods 118-119 are mold carriers, said rods are surely not surrounding elements, and they cannot provide rigidity,

contrary to standard mold-carriers." It is clear that the mold-carriers are positive structural elements of claim 1 of the patent. It is further clear that the mold carriers limitation was amended and argued by applicant to overcome a prior art rejection. The present claims 22 and 27 have been amended to further define the structure of the mold shell to have at least two axial positioning assemblies or coupling members to fix the shell in an axial direction with respect to a mold shell holder, but the absence of the mold carriers being in the shape of enveloping structures and the at least one quick fixing means constitutes recapture. See *In re Clement*, 45 USPQ2d 1161 (Fed. Cir. 1997).

Newly added claims 32-44 do not include any limitations of the shell holder and are thus further removed from the amended claim 1 of the Patent. Applicant has argued that claim 22 recites the shape of the mold carrier by the shape of the shell holder. It is not clear how claims 32 or 38 have any limitation to overcome the recapture rejection. Claims 32 and 38 not only do not recite the mold carrier, but also fail to recite the shell holder. Since the mold carrier was amended to overcome a prior art rejection it is clear that the new claims are attempting to recapture subject matter to the mold shell only.

6. Applicant's arguments filed 07 September 2004 have been fully considered but they are not persuasive.

First, applicant has made no mentioning of the rejection based on the defective declaration in regards to the failure to list the foreign priority. Second, claims 22-31 have been amended without the submission of a supplemental declaration. Third, claims 32-44 have been added without the submission of a supplemental declaration.

Applicant argues the recapture rejection by stating that the shape limitation has not been removed. This is the main issue in this case. The examiner's position is such that the mold carriers and their shape have been left out of the present claims.

Applicant attempts to amend the shape of the shell holder by stating "said shell holders being shaped to be supported by two mold carriers made in the form of enveloping structures moveable one with respect to the other." The examiner cannot agree that this significantly limits the structure of the shell holders as the shell holders as shown in figure 1 can be sufficiently supported by flat platens as done in rectilinear mold closing and clamping assemblies well known in the art. The enveloping mold carrier is more a function of the book-style or clam-shell type closing and clamping assembly disclosed in the patent and not the specific shape of the shell holder. It is the examiner's position that the claims as amended in this reissue application fail the first step of the recapture rule process, as the mold carriers and their shape, and the quick-fixing means are absent from each of the independent claims. The fact that the axial positioning means is now a limitation and thus the claims are more defined for this reason is irrelevant as the independent claims are broader in regard to the surrendered subject matter-the mold carriers and their shape. It is clear from the record of the patented file that the mold carrier limitation was amended to overcome a prior art rejection and specifically argued in the remarks accompanying said amendment.

The arguments regarding the changing of statutory class from a process or machine claim to an article claim which are functional descriptive material stored on a Computer-Readable Medium are not convincing. Applicant has taken a fact specific

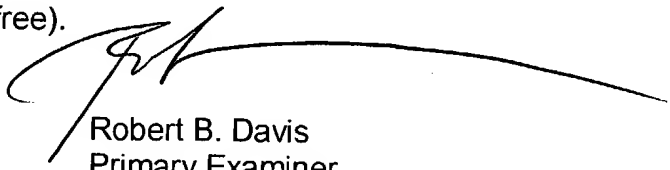
example, which is believed to be due to changes in patent law in regards to software patents and tried to extrapolate this fact specific example to a combination-subcombination situation within the same category of invention, which is apparatus or a machine. Applicant has not provided any evidence that eliminating elements in a machine claim to pursue a subcombination of an allowed combination avoids the recapture rule.

Applicant further argues that there is no evidence that applicant surrendered the ability to claim the invention via a different statutory category; however, combination and subcombination are not different statutory categories. It is clear that combination claims and subcombination claims are related inventions, which can be distinct. See MPEP section 806.05. Clearly, these types of claims are related as both are used industrially to make blow molded articles.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Davis whose telephone number is 571-272-1129. The examiner can normally be reached on Monday-Friday 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benjamin L. Utech can be reached on 571-272-1137. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robert B. Davis
Primary Examiner
Art Unit 1722

9/29/04